



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
WWW.USPTO.GOV

Paper No. None

FOLEY & LARDNER  
777 EAST WISCONSIN AVENUE  
SUITE 3800  
MILWAUKEE WI 53202-5308

**COPY MAILED**

**MAY 23 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Mark A. Baloga et al. :  
Application No. 10/026,964 : DECISION ON PETITION UNDER  
Filed: December 21, 2001 : 37 C.F.R. §1.183  
Attorney Docket Number: 076507- :  
0421 :  
Title: UTILITY DISTRIBUTION :  
SYSTEM :

Background

This is a decision on the petition filed December 30, 2004, pursuant to 37 C.F.R. §1.183, requesting that 37 C.F.R. §1.312 be waived so that Petitioner may receive the benefit of two previously filed non-provisional applications via the entry of an amendment which was supplied subsequent to the mailing of the notice of allowance.

The application was filed on December 21, 2001, and the specification on filing claimed benefit to applications 09/183,023 and 09/887,519. The specification did not indicate how these applications are related to the present application. The transmittal sheet included on filing indicates that the present application is a divisional of both of these applications. No Application Data Sheet was filed in conjunction with this application.

The petition fee of \$400 has been charged to Petitioner's Deposit Account, as authorized in the petition.

Petitioner maintains that this constitutes an extraordinary situation where justice requires the waiver of rule 37 C.F.R. §1.312 to allow the amendment of the priority claim.

Applicable Statute and Rules

35 U.S.C. 120    Benefit of earlier filing date in the United States.

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.

(Amended Nov. 14, 1975, Public Law 94-131, sec. 9, 89 Stat. 691; Nov. 8, 1984, Public Law 98-622, sec. 104(b), 98 Stat. 3385; Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-563 (S. 1948 sec. 4503(b)(1)).)

§ 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a)

- (1) A nonprovisional application or international application designating the United States of America may claim an invention disclosed in one or more prior-filed copending nonprovisional applications or international applications designating the United States of America. In order for an application to claim the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America, each prior-filed application must name as an inventor at least one inventor named in the later-filed application and disclose the named inventor's invention claimed in at least one claim of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior-filed application must be:

- (i) An international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America; or
- (ii) Complete as set forth in § 1.51(b); or
- (iii) Entitled to a filing date as set forth in § 1.53(b) or § 1.53(d) and include the basic filing fee set forth in § 1.16; or

- (iv) Entitled to a filing date as set forth in § 1.53(b) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(f).
- (2)
  - (i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (see § 1.14).
  - (ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371 (b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed application. These time periods are not extendable. Except as provided in paragraph (a)(3) of this section, the failure to timely submit the reference required by 35 U.S.C. 120 and paragraph (a)(2)(i) of this section is considered a waiver of any benefit under 35 U.S.C. 120, 121, or 365(c) to such prior-filed application. The time periods in this paragraph do not apply if the later-filed application is:
    - (A) An application for a design patent;
    - (B) An application filed under 35 U.S.C. 111 (a) before November 29, 2000; or
    - (C) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.
  - (iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§1.76), or the specification must contain or be amended to contain such reference in the first sentence following the title.

37 C.F.R. §1.183

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or

on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §1.17(h).

§ 1.312 Amendments after allowance.

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

[Para. (b) revised, 58 FR 54504, Oct. 22, 1993, effective Jan. 3, 1994; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

### Analysis

37 C.F.R. §1.78(a) indicates that applicants may claim benefit to prior-filed copending nonprovisional applications, but in order to do so, 37 C.F.R. §1.78(a)(2)(i) states that the application number of the parent must be listed, as well as the relationships of the applications. 37 C.F.R. §1.78(a)(2)(iii) indicates that this reference must be in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence following the title.

With this petition, Petitioner has submitted an amendment which identifies the present application as a divisional of applications 09/183,023 and 09/887,519. Unfortunately, a Notice of Allowance was mailed on September 30, 2004, and 37 C.F.R. §1.312 indicates that amendments may not be made as a matter of right in an application after the mailing of the notice of allowance.

Petitioner wishes to have 37 C.F.R. §1.312 waived, so that the specification can be amended subsequent to the mailing of the notice of allowance.

In order to submit a grantable petition under 37 CFR 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not shown that either condition exists in this case.

The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. The failure to timely submit the proper amendment which introduces the required relationship into the specification within the time period set forth in 37 CFR 1.78(a)(2)(ii) was a circumstance entirely within Petitioner's control, and the failure to include the relationship of the priority applications to the present application could have been avoided by the exercise of reasonable care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence<sup>1</sup>.

Furthermore, since the USPTO did not cause or contribute to Petitioner's delay, this case is even further removed from consideration as one where "justice requires" equitable relief<sup>2</sup>. It is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR §1.183<sup>3</sup>. Rather, as petitioner failed to comply with the provisions of the C.F.R. cited above, this is not an "extraordinary situation" where "justice requires" an extraordinary remedy.

Finally, the rules provide a remedy for this particular situation: in order to claim the benefit of these two prior-filed applications, Petitioner has the option of filing a petition to withdraw the present application from issue pursuant to 37 C.F.R. §1.313, coupled with the filing of a Request for Continued Examination (RCE) pursuant to 37 C.F.R. §1.114, with the amendment to the specification serving as the submission as described in section (c) of this latter title.

---

1 U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

2 See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

3 See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir.1996); Nitto Chemical Industry Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule).

It follows that Petitioner's circumstances are not extraordinary, and justice fails to require waiver of rule 37 C.F.R. §1.312.

Conclusion

The petition is **DISMISSED**.

37 C.F.R. §1.312 will not be waived, and priority will not be accorded to applications 09/183,023 and 09/887,519 without the filing of a petition to withdraw from issue coupled with an RCE, as discussed above.

The petition fee of \$400 will not be refunded, as this petition was not necessitated by any error on the part of the Office.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.183." This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski.

Any renewed petition may be submitted by mail<sup>4</sup>, hand-delivery<sup>5</sup>, or facsimile<sup>6</sup>.

**The application file will be retained in the Office of Petitions for two (2) months.**

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



**Paul Shanoski**  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office

---

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

6 (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.